REMARKS

Claims 1 – 46 remain in the application and stand rejected. Although this amendment is being timely filed, the Commissioner is hereby authorized to charge any fees that may be required for this paper or credit any overpayment to Deposit Account No. 50-3818.

The "examiner should always look for enabled, allowable subject matter and communicate to applicant what that subject matter is at the earliest point possible in the prosecution of the application." MPEP §2164.04, last paragraph (emphasis original).

Claims 1 – 10, 14 – 17, 19 – 27, 32 – 40 and 42 – 45 are rejected as being unpatentable under 35 U.S.C. §103(a) over published U.S. Patent Application No. 2004/0205209 to Wengrovitz et al. in view of U.S. Patent No. 7,020,460 to Sherman et al. Claims 11 – 13, 18, 19, 28 – 31, 41 and 46 are rejected as being unpatentable under 35 U.S.C. §103(a) over Wengrovitz et al. and Sherman et al. in further view of published U.S. Patent Application No. 2005/0013421 to Chavez et al. The rejection is respectfully traversed.

Applicants again note that Wengrovitz et al. and Chavez et al. are published subsequent to the filing date of the present application. Again the applicants reserve the right, if necessary, to offer evidence of invention prior to one of more of these references being applied as references under 35 U.S.C. §103(a) through 35 U.S.C. §102(e). However, for reasons set forth below, such a showing is still believed to be unnecessary.

In rejecting independent claims 1, 14, 32 and 42, the Office action acknowledges that Wengrovitz et al. fails to "teach that the device may be a telephone set that employs IM capabilities." See, e.g., page 3, #3. Thus, the Office action turns to Sherman et al., asserting that Sherman et al. teaches a method "wherein full IM capability is provided to said telephone set, full IM capability including creating a buddy list (column 10, lines 20-21, where the mobile telephones may be used for instant messaging, also column 8, lines 24-35, where a user may be added to a user's buddy list)." *Id.* However, that buddy list is not for IM and, therefore,

Sherman et al. fails to teach full IM capability, including creating a buddy list, being provided to a telephone set.

"If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." §MPEP 2143.01 V (citations omitted). "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." §MPEP 2143.01 VI (citations omitted).

Sherman et al. is directed to "providing a mobile network notification service and in particular, to a method of notifying a customer if particular telephone numbers are in communication with the mobile network." Col. 1, lines 7 – 11. In particular, Sherman et al. is concerned with informing mobile network notification service customers if one or more other "customer's telephone is turned on and connected to the mobile network without calling the customer's telephone number." *Id*, lines 60 – 62. Thus, the Sherman et al.

> invention provide[s] the ability for a mobile telephone customer of a provider network to known [sic] when another mobile customer of the provider network (or another provider network that has partnered with the provider network or partnering Internet Service Providers (ISP's)) **has their telephone turned on in the mobile network**. Given this knowledge, the mobile telephone customer may then call the other mobile customer or send the other mobile customer a message using an instant messaging facility as is known in the art.

Col. 3, line 20 – 29 (emphasis added). Regarding those customers, however, the system of Sherman et al. Figure 1 includes a notification database in storage device 128 that "is relational and includes one or more records correlating a mobile telephone customer with other mobile telephone customers that have allowed the mobile telephone customer to view their current mobile telephone status." Col. 4, lines 53 – 58. Thus, when Sherman et al. discusses adding to a buddy list (noted by the Office action, *supra*), Sherman et al. continues:

> The server application checks the notification database 128 for the new telephone number that the customer wants to add to the notification list and confirms that the owner of this telephone number has permitted this customer to add the number to his "buddy list." If the telephone number has permission to be added to the

> customer notification list, the server application **updates** the customer profile **in** the **database** with the new "buddy list."

Col. 8, lines 35 – 42 (emphasis added).

Very clearly, while Sherman et al. was well aware of instant messaging, the Sherman et al. "buddy list" is separate from any IM buddy lists. Moreover, since the primary purpose of Sherman et al. is to keep mobile network customers aware of each others' availability; replacing the Sherman et al. "buddy list" with an IM buddy list "would change the principle of operation" as there is nothing in Sherman et al. to teach how to use an IM buddy list to keep mobile network customers aware of each others' availability; and, therefore,the replacement would render Sherman et al. "unsatisfactory for its intended purpose." *Supra*. Therefore, "there is no suggestion or motivation to make the proposed modification" of Wengrovitz et al. and "the teachings of the references are not sufficient to render the claims *prima facie* obvious." *Supra*. Nor does Chavez et al. add what is missing or cure these deficiencies.

Further, as previously noted, dependent claims include all of the differences with the references, as the claims from which they depend. MPEP §2143.03 ("If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)."). Therefore, the combination of Wengrovitz et al. and Sherman et al., alone or further in combination with Chavez et al. fails to result in the present invention as recited in, teach or suggest dependent claims 2 – 13, 15 – 31, 33 – 41 and 43 – 46, which depend from claims 1, 14, 32 and 42. Reconsideration and withdrawal of the rejection of claims 1 – 46 under 35 U.S.C. §103(a) is respectfully requested.

The applicants thank the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance for the reasons set forth above, the applicants respectfully request reconsideration and withdrawal of the rejection of claims 1 – 46 under 35 U.S.C. §103(a) and allowance of the application to issue.

Applicants have previously noted that MPEP §706 "Rejection of Claims," subsection III, "PATENTABLE SUBJECT MATTER DISCLOSED BUT NOT CLAIMED" provides in pertinent part that

> If **the examiner** is satisfied after the search has been completed that patentable subject matter has been **disclosed** and the record indicates that the applicant intends to claim such subject matter, he or she **may note** in the Office action that **certain aspects or features** of the patentable invention have not been claimed and that if properly claimed such claims **may be given favorable consideration**.

(emphasis added). The applicants believe that the written description of the present application is quite different than, and not suggested by, any reference of record. Accordingly, should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney at the local telephone No. listed below for a telephonic or personal interview to discuss any other changes.

Respectfully submitted,

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